

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3652

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4/10/03

In re

Patent Application of

James R. Michler, et al.

Application No. 09/917,179

Confirmation No. 9647

Filed: July 27, 2001

Examiner: Michael J. Kwon

"APPARATUS AND METHOD FOR STACKING
SHEETS DISCHARGED FROM A STARWHEEL
ASSEMBLY"

I, Mary Beth Geipel, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

Mary Beth Geipel
Signature

March 24, 2003
Date of signature

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This communication is in response to the Office action dated February 24, 2003. Applicants respectfully request the Examiner to enter and consider the following remarks.

The Examiner has identified in the application six groups of claims as follows: Group I (claims 1-19 and 81-87) drawn to an apparatus for stacking sheets; Group II (claims 20-34 and 88-95) drawn to a method for stacking sheets; Group III (claims 35-56) drawn to a controller; Group IV (claims 57-77) drawn to programming a controller; Group V (claims 96-108) drawn to a conveyor; and Group VI (claims 109-118) drawn to a method of conveying.

In response to the restriction requirement, Applicants hereby elect to prosecute Group II (claims 20-34 and 88-95) with traverse, and respectfully request reconsideration of the restriction requirement.

Two criteria must be met for a proper restriction requirement: (1) the inventions must be patentably independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is not required. See *Manual of Patent Examining Procedure*, § 803. The M.P.E.P. defines "independent" to mean there is no relationship between the two or more subjects disclosed (M.P.E.P. § 802.01). The M.P.E.P. defines "distinct" to mean that the two or

more disclosed subjects are related, but are capable of separate manufacture, use, or sale as claimed, and are patentable over each other.

With regard to the restriction between the claims of Groups I and II, the Examiner states that the process as claimed in Group II can be performed by another apparatus that is materially different from the apparatus claimed in Group I. Specifically, the Examiner states that the method of Group II can be performed by hand. Applicants respectfully submit that the method claimed in Group II cannot be performed by hand. The claims of Group II require either “inserting a first separator finger between two adjacent sheets positioned within the starwheel assembly” or “separating sheets in the starwheel by moving the separator finger”. It would be impossible to separate two sheets within a starwheel by hand because of the extremely precise timing and positional control required to separate two sheets moving within a starwheel. Applicants therefore respectfully submit that the restriction between the claims of Groups I and II should be withdrawn.

Even if the two or more disclosed subjects are independent and distinct, in order for a proper restriction, there must also be a serious burden on the patent examiner if the restriction is not required (*M.P.E.P.* § 803). If the search and examination can be completed without a serious burden, the examiner must evaluate the merits regardless of whether or not two or more independent or distinct subjects are disclosed. Applicants respectfully submit that a serious burden is not placed on the Examiner in searching and examining the claims of Groups I and II together. Applicants note that the claims of Group I and II are related as process and apparatus for its practice, respectively, and are drawn to a specific technology.

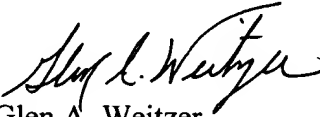
The Examiner has indicated that each of Groups I and II falls within a different class (i.e., Group I classified in class 271; and Group II classified in class 414). However, there does not appear to be a proper basis for classifying these Groups in these different classes. Class 271 is defined as technology concerning the stacking or unstacking of individual sheets of unfolded paper or thin, substantially flat articles that are temporarily bent or flexed during handling. Class 414 is defined as technology concerning the stacking of paper sheets that would otherwise proper for Class 271 except that the stack formed is subsequently handled as a unit and moved away from the location where it was formed. There appears to be no distinction in the claims of Group I and II that requires the claims to be assigned to these different classes. In particular, classes 271 and 414 appear to be equally relevant to the claims of Group I and II. If the restriction

requirement is upheld, explanation of why Groups I and II have been classified in these different classes is respectfully requested.

Accordingly, Applicants respectfully submit that Groups I and II in the present application can and should be examined together. Particularly in light of the fact that such an examination would not present a "serious burden" to the Examiner in the present case, Applicants hereby request withdrawal of the restriction requirement, particularly with regard to Groups I and II. If the restrictions are upheld, Applicants hereby elect Group II (claims 20-34 and 88-95) with traverse and request consideration of the elected claims on the merits.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,


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